The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte LEE A. BRADFORD

Appeal No. 2005-1613
Application No. 10/053,748

ON BRIEF

Before THOMAS, KRASS, and LEVY, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

REMAND TO EXAMINER

This is a remand of the appeal under 35 U.S.C. § 134 from the rejection of claims 1-38, in accordance with 37 CFR § 41.50(a)(1). After considering the entire record before us, we are convinced that the instant appeal is not ready for a meaningful review. Accordingly, we hereby remand the application to the examiner to consider the following issues, and to take appropriate action.

Background

Representative claim 1 is reproduced below:

1. A method of determining a revision of a test suite of a model-based diagnostic testing system comprising:

evaluating a diagnostic efficacy of the lest suite using a probability of one or both of a correct diagnosis and an incorrect diagnosis by the test suite.

The following references are relied on by the examiner:

Preist et al. (Preist)	5,808,919	Sep. 15, 1998
Booth et al. (Booth)	5,922,079	Jul. 13, 1999
Kanevsky et al. (Kanevsky)	6,167,352	Dec. 26, 2000

Of the pending claims 1-38, the examiner has indicated in the final rejection and again at pages 7-9 of the answer that claims 9 and 12-30 are objected to as being dependent upon rejected based claims but would be allowed if rewritten in independent form including all of limitations of the base claim and intervening claims. Thus, claims 1-8, 10, 11 and 31-38 remain for our consideration on appeal.

The examiner has set forth three stated rejections of the claims that remain on appeal. Claims 1-7, 10, 11 and 32-36 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Booth. Claims 8 and 32 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies Booth in view of

Kanevsky. Lastly, claim 38 stands rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies Booth in view of Preist. Despite the examiner's three stated rejections, apparently claims 31 and 37 have not been formally rejected.

Reasons for remand

The three stated rejections noted earlier in this opinion as set forth at pages 3-7 of the answer do not formally establish a rejection of dependent claims 31 and 37. Therefore, technically, we have no jurisdiction to review patentability question of these two claims since they have not been rejected apparently at all. Moreover, assuming for the sake of argument, that claim 31 has actually been rejected by the examiner in some manner, the examiner states at the bottom of page 14 of the answer that the examiner agrees with appellant's arguments as to this claim as set forth in the brief. A similar statement is made by the examiner at page 19 of the answer as to claim 37. Even though the examiner has stated that the examiner agrees with appellant's positions as to these two claims as set forth in the brief, the examiner does not formally withdraw any rejection of them.

A similar approach is followed by the examiner as to claims 3-5, 7, 8, 10, 35 and 36 beginning in the Response to Argument

portion of the answer at page 11. Again, we are not sure whether the examiner has formally withdrawn the rejection of these claims.

In a related issue, the examiner has set forth a rejection under 35 U.S.C. § 103 of dependent claim 38 as set forth at pages 6 and 7 of the answer. On the other hand, there is no responsive argument directed to this claim following a brief discussion of claim 37 at page 19 of the answer. Therefore, it appears problematic the examiner has maintained the rejection of claim 38 in view of the appellant's arguments in the brief regarding this claim.

Similar confusion appears to exist with respect to the second stated rejection of claims 8 and 32 under 35 U.S.C. § 103 in view of Booth and Kanevsky. The subject matter of dependent claim 8 corresponds to the subject matter of dependent claim 37, for which there was no corresponding stated rejection under 35 U.S.C. § 103 over Booth and Kanevsky. Since independent claim 32 has already been rejected under 35 U.S.C. § 102 in the first stated rejection, it appears to us that the subject matter actually intended by the examiner was not the subject matter of claim 32 as expressed at the top of page 6 of the answer, but the

subject matter of dependent claim 31 which does recite a Monte Carol [sic, Carlo] approach where features are identified in Kanevsky as to this recited feature in dependent claim 31.

In addition to appellant's comments at the top of page 3 of the reply brief that the examiner has not formally listed the reliance upon Preist and Kanevsky in the listing of references relied upon at page 3 of the answer, even though these latter two references are relied upon in the statements of the rejections, we also agree with appellant's observation that the rejections of dependent claims 3, 4, 5, 7, 8, 10, 31, 35, 36 and 37 appear to have been withdrawn by the examiner as expressed at page 3 and 4 of the reply brief. Correspondingly, the only claims remaining on appeal for our consideration is the rejection of claims 1, 2, 6, 11, 32, 33 and 34 under 35 U.S.C. § 102 as being anticipated by Booth.

The basic issue from appellant's perspective regarding each of independent claims 1, 11 and 32 on appeal revolves around the language best stated in independent claim 1 on appeal:

> evaluating a diagnostic efficacy of the test suite using a probability of one or both of a correct diagnosis and an incorrect diagnosis by the test suite.

All of appellant's arguments in the brief and reply relate to this argued feature as to the independent claims 1, 11 and 32.

From the examiner's perspective, there is also continued reliance briefly upon Booth's discussion at column 9, lines 14 and 15 as well as the discussion generally at the middle of column 11 regarding the probability limitation noted earlier. It appears to us from our study of Booth that both the examiner and appellant has failed to appreciate the nature and teachings of Booth. The Field of Invention at the top of column 1 of Booth plainly indicates that the disclosure in Booth relates to enhancements of a model-based diagnostic system. This is plainly stated as well at column 6, lines 34 and 35 where the model-based diagnostic system 106 of Figure 1 is indicated to be the prior art diagnostic system of Preist, the discussion which begins at column 1, line 40. This same Preist reference is formally relied on by the examiner to reject claim 38. At column 2, there is substantial discussion of databases which not only buttresses the simulated database 124 as well as the historical database 126 in Booth's system in Figure 3 but all three of which relate directly to the feature of creating a simulation database of independent claim 11 on appeal. Moreover, the modeling approach discussed at columns 3-5 of Booth relating to this earlier Preist application

clearly sets the proper perspective for the examiner-relied upon weighting suggesting probability as well as direct teachings of probability generations known in the art such as those discussed at columns 3 and 4. Moreover, as revealed initially in the abstract, Booth fully has the ability to add or delete portions of a test suite in his diagnostic test model as illustrated in Figure 3 at element 310 to the extent they are recited in dependent claims 2 and 6 on appeal. In view of these remarks, the corresponding features of dependent claims 33 and 34 also appear to be taught.

In light of these comments, we are perplexed that the examiner has not rejected dependent claim 3, for example only, or appears to have withdrawn the rejection of dependent claim 3, which sets forth subject matter corresponding to claim 34, the rejection of which is explicitly maintained by the examiner. Since the examiner has only apparently withdrawn the rejection of claims 3-5, 7, 8, 10, 31 and 35-38, based upon the additional material we have outlined in the initial columns of Booth that properly sets forth the context under which the exact teachings of Booth must be viewed, we remain perplexed that the examiner has withdrawn the rejection of these claims. They appear rejectable.

In view of the examiner's and appellant's apparent incomplete consideration of the teaching value of Booth, and in view of the earlier-noted apparent but not explicit withdrawal of certain claims on appeal, it appears to us that the present appeal is not ripe for meaningful review. Accordingly, this application is remanded to the examiner to consider the earlier-noted issues and to take appropriate action as necessary.

This application, by virtue of its "special" status, requires an immediate action. MPEP § 708.01(D)(8th Ed., Rev. 2, May 2004). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REMANDED

JAMES D. THOMAS)
Administrative Patent Judge)
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) BOARD OF PATENT
ERROL A. KRASS) APPEALS AND
Administrative Patent Judge) INTERFERENCES
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STUART S. LEVY)
Administrative Patent Judge)

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AGILENT TECHNOLOGIES, INC.
LEGAL DEPARTMENT DL429
INTELLECTUAL PROPERTY ADMINISTRATION
P.O. BOX 7599
LOVELAND, CO 80-537-0599